



PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: A7934

BAKMAN, ALEXANDER, et al.

Appln. No.: 09/481,069

Group Art Unit: 2176

Confirmation No.: 5153

Examiner: C. PAULA

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Filed: January 11, 2000

For: **METHOD AND SYSTEM FOR AUTOMATIC DOCUMENTATION OF
CONFIGURABLE SYSTEMS**

APPELLANT'S BRIEF ON APPEAL UNDER 37 C.F.R. § 1.192

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

The following comprises the Appellant's Brief on Appeal from the rejection dated December 4, 2002, rejecting claims 1-113. This Appeal Brief is filed in triplicate and is accompanied by a Submission which includes the required appeal fee set forth in 37 C.F.R. § 1.17(f). Appellant's Notice of Appeal was filed on May 21, 2002. Subsequently, a second final Office Action dated August 26, 2002 was followed by a non-final Office Action dated December 4, 2002 issued in reply to Appellant's Response filed November 6, 2002. Appellant files herewith a Petition for Extension of Time (with fee) extending the due date for responding to the non-final Office Action dated December 4, 2002 to June 4, 2003. Therefore, the present Appeal Brief is timely filed.

APPELLANTS' BRIEF ON APPEAL
UNDER 37 C.F.R. § 1.192
U.S. Appln. No.: 09/481,069

I. REAL PARTY IN INTEREST

Appellant respectfully submits that the above-captioned application is assigned in its entirety to ECORA CORPORATION, a company organized under the laws of United States.

II. RELATED APPEALS AND INTERFERENCES

Appellant states that, upon information and belief, Appellant is not aware of any co-pending appeal or interference which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

This is an appeal from the rejection dated December 4, 2002, wherein claims 1-113 were rejected for the third time.

The present application is a CPA of Application No. 09/481,069 filed January 11, 2000. The present application was filed on March 9, 2001 adding claims 98-113 in a Preliminary Amendment filed therewith. An Amendment Under 37 C.F.R. §1.111 was filed October 5, 2001, amending independent claims 1, 8, 18, 36, 39, 43, 49, 55, 59, 67, 78, 80, 86, 91, 94 and 95 to more clearly define the features which were believed to have been implicitly defined in these claims as previously amended by Appellant's Preliminary Amendment filed March 9, 2001 with the CPA. No amendments were made to the application after the October 5, 2001 Amendment.

APPELLANTS' BRIEF ON APPEAL
UNDER 37 C.F.R. § 1.192
U.S. Appln. No.: 09/481,069

Claims 1-113 are all the claims pending in the application, and stand rejected under 35 U.S.C. § 103(a) as follows:

- Claims 1-30, 32-41, 43, 45-58, 60-90, 96-106 and 18-111 as being unpatentable over Isaacson et al.(Isaacson) in view of Danknick et al. (Danknick);
- Claims 31, 42 and 44 as being unpatentable over Isaacson in view of Danknick and further in view of Noble et al. (Noble);
- Claim 59 as being unpatentable over Isaacson in view of Danknick and further in view of Dunphy et al. (Dunphy); and
- Claims 91-95, 107, 112 and 113 as being unpatentable over Danknick.

Accordingly, claims 1-113 (see attached Appendix) are the claims currently on appeal, from these rejections under 35 U.S.C. §103(a).

IV. STATUS OF AMENDMENTS

All of the filed Amendments and Responses have been entered.

V. SUMMARY OF THE INVENTION

Appellant's invention provides novel systems, methods and software for production of documentation for configurable computerized systems. In particular, these systems, methods and software define unique combination of requirements including, *inter alia*, organizing explanatory information corresponding to system configuration parameters and a value associated with these

APPELLANTS' BRIEF ON APPEAL
UNDER 37 C.F.R. § 1.192
U.S. Appln. No.: 09/481,069

parameter into a narrative format descriptive of the configuration of the configurable system.

The narrative format being such that it constitutes the documentation, or a portion of the documentation, for a configurable system. That is, the documentation produced in accordance with Appellant's invention is an organized collection of knowledge, that separately or in combination, represents the state or configuration of a system. By way of example and not limitation, such documentation may be of use in teaching system operation and troubleshooting (see specification, pages 13-19 and Figs. 12 and 13).

One of the key features of Appellant's inventions is organizing the explanatory information, based on either (or both) the content of the information or/and the value associated with the retrieved configuration system parameter, into a narrative format descriptive of the configuration of the configurable system such that the integrated narrative format constitutes the documentation, or a portion of the documentation, of the configurable system (see specification, pages 20-23). (See also, International Preliminary Examination Report, issued October 17, 2001, in the corresponding PCT application (PCT/US00/04510), Examiner's reasoned statement under Article 35(2)).

VI. ISSUES

1. Whether claims 1-30, 32-41, 43, 45-58, 60-90, 96-106 and 18-111 are patentable over Isaacson et al.(Isaacson) in view of Danknick et al. (Danknick) within the requirements of 35 U.S.C. § 103(a)?
2. Whether claims 31, 42 and 44 are patentable over Isaacson in view of Danknick and further in view of Noble et al. (Noble) within the requirements of 35 U.S.C. § 103(a)?
3. Whether claim 59 is patentable over Isaacson in view of Danknick and further in view of Dunphy et al. (Dunphy) within the requirements of 35 U.S.C. § 103(a)?
4. Whether claims 91-95, 107, 112 and 113 are patentable over Danknick within the requirements of 35 U.S.C. § 103(a)?

VII. GROUPING OF CLAIMS

Claims 8, 18, 31, 42, 44 55, 59, 67 and 86 recite additional, individually patentable feature, and therefore, stand or fall individually, as noted in Section VIII on pages 8 and 9. The remaining claims stand or fall together.

VIII. ARGUMENTS

None of the prior art references (applied alone or in any reasonable combination) discloses, teaches or suggests systems, methods and software for production of documentation for configurable computerized systems having at least the feature of:

organizing said explanatory information ["corresponding with at least one of said configuration parameters and a value associated with said parameter"] ... into a narrative format descriptive of the configuration of the configurable system, the narrative format constituting the documentation, or a portion of the documentation, for said configurable system (Appellant's independent claim 1; see also claims 36, 49, 78, 94 and 95)

or

outputting explanatory information corresponding with at least one of said configuration parameters and a value associated with said parameter in a narrative format descriptive of the configuration of the configurable system, to form the documentation or a portion thereof (Appellant's independent claim 8; see also claims 18, 39, 43, 55, 59, 67, 80, 86 and 91)

In particular, Isaacson provides "a method and apparatus for automatically configuring a number of communication programs that are resident on a number of computer platforms," wherein "[t]he configuration program solicits user configuration information from a user through a user interface" (Id., col. 2, lines 17-27). Thus, in contrast to Appellant's claimed invention, Isaacson configures programs resident on configurable computerized systems (i.e., the "computer platforms"), rather than organizing or outputting explanatory information to form documentation for these systems. As such, the Examiner acknowledges that Isaacson does not

APPELLANTS' BRIEF ON APPEAL
UNDER 37 C.F.R. § 1.192
U.S. Appln. No.: 09/481,069

disclose, teach or suggest "outputting explanatory text segments corresponding with at least one of said configuration parameters ..." (See Office Actions, dated December 21, 2001, August 26, 2002 and December 4, 2002).

On the other hand, Danknick discloses a method and apparatus for communicating with a network peripheral (such as a copier) wherein current configuration settings of the peripheral are transferred and displayed in the form of an "Administration" HTML page 150 downloaded from the HTTP server 64. (See Danknick, col. 7, lines 1-20, and Figs. 9 and 10). Danknick's "Administration" HTML page does not organize or output information in "a narrative format descriptive of the configuration of the configurable system" [such system as, HTTP server 64, a network, or a copier attached thereto], and does not form or constitute "the documentation or a portion thereof" of the configurable system, as required by Appellant's claimed invention.

That is, Danknick's HTML page does not contain information presented in a narrative format so as to form documentation of a configurable system, but is a user interface wherein configuration parameters of a peripheral are displayed together with icons "which, when selected, cause administrative functions to be executed within the [peripheral]" (see Danknick, col. 7, lines 12-20 and col. 7, line 66 through col. 9, line 26).

In fact, in the Office Action dated August 26, 2002 the Examiner acknowledged that the combination of Isaacson and Danknick did not disclose creation of documentation information in a narrative format as required by Appellant's claimed invention. Indeed, the Examiner relied on an unrelated reference, Poole to supply this acknowledged deficiency.

APPELLANTS' BRIEF ON APPEAL
UNDER 37 C.F.R. § 1.192
U.S. Appln. No.: 09/481,069

In the subsequent Office Action, dated December 4, 2002, after conceding that reliance on Poole was based on impermissible hindsight, vis-à-vis Appellant's own disclosure, the Examiner when formulating the prior art rejections simply ignores the requirement of organizing explanatory information corresponding with at least one of the configuration parameters and a value associated with said parameter into a narrative format descriptive of the configuration of the configurable system, as recited in Appellant's independent claims,. Clearly, the Examiner has now failed to formulate a prima facie case of obviousness, and the application should proceed to allowance at least for this reason.

Of course, on the merits, since Noble and Dunphy likewise do not disclose, teach or suggest the above noted features of Appellant's invention, Appellant's independent claims 1, 8, 18, 36, 39, 43, 49, 55, 59, 67, 78, 80, 86, 91, 94 and 95, as well as the dependent claims 2-7, 9-17, 19-38, 40-42, 44-48, 50-53, 56-58, 60-66, 68-77, 79, 81-85, 87-90, 92, 93 and 96-113 (which incorporate all the novel and unobvious features of their respective base claims), would not have been obvious from any reasonable combination of the cited prior art references.

In addition to the novel and unobvious features noted above, claims 8, 18, 55, 59, 67 and 86 define other novel aspects of Appellant's invention which facilitate automatic production of documentation for configurable computerized systems. By way of illustration, one of the features recited in Appellant's claims 8, 43, 55 and 86 is:

constructing a table of contents for said documentation, or a portion thereof (claim 8, see also claims 43, 55 and 86)

APPELLANTS' BRIEF ON APPEAL
UNDER 37 C.F.R. § 1.192
U.S. Appln. No.: 09/481,069

On the other hand, Appellant's claims 18 and 67 recite:

generating an index of at least selected parameters of said configuration parameters, and said explanatory information, said index detailing relative location of at least one of said selected parameters and at least a portion of said explanatory information within said document (claim 18; see also claim 67)

None of the cited prior art references discloses, teaches, or suggests "constructing a table of content" or "generating an index" for any of the information which these prior art references may generate, let alone teach or suggest doing so for configuration parameters, or for the explanatory information associated with such parameters. Likewise, with regard to claim 59, none of the prior art references discloses, teaches or suggests "maintaining an activity log detailing operations of said steps of retrieving [configuration parameters] and outputting [explanatory information corresponding with at least one of said configuration parameters]", as recited therein.

Furthermore, Appellant's dependent claim 31, 42 and 44 provide methods and system for updating the documentation by determining and outputting the changes in system configuration parameter. The Examiner alleges that Noble discloses this acknowledged deficiency of Isaacson and Danknick. However, as correctly noted by the Examiner, the only function of Noble is to update web pages from the Internet and to indicate the changes occurring therein. Nowhere does Noble disclose or suggest that its method of keeping track of changes in Internet web page is applicable to monitoring and ascertaining changes in system configuration parameters. In fact, neither Isaacson nor Danknick describe or suggest such a feature. Again, the Examiner is relying

APPELLANTS' BRIEF ON APPEAL
UNDER 37 C.F.R. § 1.192
U.S. Appln. No.: 09/481,069

on Appellant's own disclosure to provide the missing teachings. This is impermissible use of hindsight.

Accordingly, Appellant's claims 1-113 recite patentable novel and unobvious features, and thus, would not have been obvious from any reasonable combination of Isaacson, Danknick, Noble and Dunphy.

The present Brief on Appeal is being filed in triplicate. Unless a check is submitted herewith for the fee required under 37 C.F.R. § 1.192(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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